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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 779,323	02/08/2001	Carsten Sjoeholm	NOVT 200	9039

7590 03/01/2002

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EXAMINER

MONSHIPOURI, MARYAM

ART UNIT	PAPER NUMBER
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1652

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DATE MAILED: 03/01/2002

Please find below and or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/779,323**

Applicant(s)  
**Sjoeholm et al.**

Examiner  
**Maryam Monshipouri**

Art Unit  
**1652**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-13 are subject to restriction and/or election requirement.

## Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) All b) Some\* c) None of:
1. Certified copies of the priority documents have been received.

- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a method of animal feed preparation wherein said feed comprises acid resistant protease from *Nocardiopsis* sp. Set forth as SEQ ID NO:1 and *Nocardiposis alba* set forth as SEQ ID NO:2, classified in class 435, subclass 220.
- II. Claims 6-10 and 13, drawn to animal feed additives and animal feed compositions comprising said proteases, classified in class 426, subclass 656.
- III. Claims 11-12, drawn to methods of treatment of vegetable proteins comprising adding at least one of the above mentioned acid-resistant proteases, classified in class 435, subclass 68.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the protease compositions may be made with acid-stable proteases from other species which are

Inventions II and III are related as product and process. Inventions II and III are distinct if either or both of the following can be shown: (1) the process for using the protease compositions may be used to make other and materially different products or (2) the product as claimed can be made by another and materially different process (MPEP § 806.05(f)).

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as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protease compositions may be used for antibody preparation which is an entirely different method than that of Group III.

Methods of Groups I and III are patentably distinct because each method has different steps and different end-points.

Applicant is also reminded that **claims 1-13 are generic to two patentably distinct inventions (i.e. products of unrelated chemical structure and function) : (A) proteases from *Nocardiopsis* sp. (SEQ ID NO:1), and methods of using said products, (B) proteases from *Nocardiopsis alba* (SEQ ID NO:2), and methods of using said products.**

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their separate classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention (either directed to SEQ ID NO:1 or SEQ ID NO:2) to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the

amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Maryam Monshipouri, Ph.D. whose telephone number is (703) 308-1083. The Examiner can normally be reached daily from 8:30 A.M. to 4:30 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. P. Achutamurthy, can be reached at (703) 308-3804. The OFFICIAL fax number for Technology Center 1600 is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Maryam Monshipouri Ph.D.

Patent Examiner